

**REMARKS**

This Amendment is being filed in response to the rejection dated January 4, 2006. No new matter is introduced by this amendment. The specification is amended to correct informalities. Support for the amendment to claim 15 is found in claim 16. For the following reasons this application should be allowed and the case passed to issue.

Claims 1-16 and 21-23 are pending in this application. Claims 8-11 and 14-16 are rejected. Claims 1-7 and 21-23 are withdrawn pursuant to a restriction requirement. Claims 15 and 16 have been amended. Claims 17-20 are canceled.

***Claim Rejections Under 35 U.S.C. § 102***

Claims 15 and 16 were rejected under 35 U.S.C. § 102(b) as clearly anticipated by Sangyo (JP 61-45125). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the invention as claimed and the cited prior art.

An aspect of the invention, per claim 15, is a strut positioning system for a foldable ladder configured for installation in an opening defined between one floor or space and another floor or space. The opening having a distal side to which a ladder is rotatably attached, a proximal side to which an opening or closing torque is applied to open or close the foldable ladder, and a first and a second lateral side. The strut positioning system comprises at least one strut having a proximal end and a distal end. A track is configured for mounting in a fixed position relative to and along one of the first lateral side and the second lateral side of the opening defined between one floor or space and another floor or space. A slide plate is configured for translational movement within the track from a first position to a second position, wherein the first position corresponds to a non-compressed state of the strut and the second

position corresponds to a compressed state of the strut. A locking member locks the slide plate in the second position. Upon connection of the distal end of the strut to one of a ladder and a link member attached to a ladder and compression of the strut, the slide plate is locked in the second position by the locking member. The track comprises a plurality of landings disposed between the first position and the second position. The landings are configured to prevent reverse translation of the slide plate in a direction toward the first position past the landing under a bias of the strut.

The Examiner asserted that Sangyo shows a strut 14, track 25, locking member 38, and connecting member 34b.

Sangyo, however, does not anticipate claim 15 because Sangyo does not disclose the track comprising a plurality of landings disposed between the first position and the second position, the landings configured to prevent reverse translation of the slide plate in a direction toward the first position past the landing under a bias of the strut, as required by claim 15.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Sangyo does not disclose the track comprising a plurality of landings disposed between the first position and the second position, the landings configured

to prevent reverse translation of the slide plate in a direction toward the first position past the landing under a bias of the strut, as required by claim 15, Sangyo does not anticipate claim 15.

Applicants further submit that Sangyo does not suggest claim 15.

Claims 16 is allowable for at least the same reasons as claim 15 and further distinguishes the claimed strut positioning system.

***Claim Rejections Under 35 U.S.C. § 103***

Claims 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sangyo in view of Talukdar et al. (U.S. Pat. Pub. No. 2003/0193199). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

An aspect of the invention, per claim 8, is a strut positioning system for a foldable ladder configured for installation in an opening defined between one floor or space and another floor or space. The opening has a distal side to which a ladder is rotatably attached, a proximal side to which an opening or closing torque is applied to open or close the foldable ladder, and a first and a second lateral side. The strut positioning system comprises at least one strut having a proximal end and a distal end and a track configured for mounting in a fixed position relative to and along one of the first lateral side and the second lateral side of the opening defined between one floor or space and another floor or space. A rack plate comprises gear teeth configured to matingly engage corresponding pinion gear teeth and comprises a connector for connecting to the proximal end of the strut. The rack plate is configured for translational movement within the track from a first position to a second position. The first position corresponds to a non-compressed state of the strut and the second position corresponds to a compressed state of the strut. A locking device is configured to lock the rack plate in the second position. A pinion gear comprising teeth is configured to matingly engage corresponding rack plate gear teeth and

comprises a torque application member configured to matingly engage a torque application tool. The pinion gear is configured to be rotatably mounted in a fixed position on the lateral side of the opening within the track. Upon connection of the distal end of the strut to one of a ladder and a link member attached to a ladder and compression of the strut by application of a torque to the pinion gear, the rack plate is locked in the second position.

The Examiner averred that Sangyo substantially discloses the claimed strut positioning system except the rack plate and pinion. The Examiner asserted that Talukdar et al. shows rack plate 231 movable by pinion gear 265. The Examiner concluded that it would have been obvious to modify Sangyo to comprise a rack plate and pinion gear to facilitate movement of the plate because it would have been an obvious mechanical expediency.

Applicants submit that the Examiner has not established a prima facie case of obviousness because there is a lack of motivation in view of the teachings of Sangyo and Talukdar et al. to modify Sangyo to achieve the claimed strut positioning system. It would not have been obvious to combine Sangyo and Talukdar et al. because these references are directed to non-analogous subject matter. Sangyo is directed to a compression spring device for a ladder, while Talukdar et al. is directed to a latch assembly for a glovebox. One of ordinary skill in this art would not look to a teaching of a glovebox latch assembly to solve a problem in a ladder.

Further, it would not have obvious to combine Talukdar et al. and Sangyo because they are mechanically very different and it is not seen how the Talukdar et al. pinion gear and lock plate would be incorporated into the Sangyo compression spring device. Furthermore, Talukdar et al. describe the pinion gear 265 as being part of a damper mechanism 227. There is no motivation to incorporate an additional damper mechanism into the compression spring device of Sangyo, as the compression spring device 14 of Sangyo functions as a damper.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). There is no suggestion in Sangyo or Talukdar et al. to modify the compression spring device of Sangyo to provide the strut positioning system, as required by claim 8.

The requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 is not an abstract concept, but must stem from the applied prior art as a whole and realistically impel one having ordinary skill in the art to modify a specific reference in a specific manner to arrive at a specifically claimed invention. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). Accordingly, the Examiner is charged with the initial burden of identifying a source in the applied prior art for the requisite realistic motivation. *Smiths Industries Medical System v. Vital Signs, Inc.*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999); *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1449 (Fed. Cir. 1997). There is no motivation in Sangyo or Talukdar et al. to modify the compression spring device of Sangyo to provide the strut positioning system, as required by claim 8.

In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to discharge the initial burden by, *inter alia*, making "**clear and particular**" factual findings as to a **specific understanding** or **specific technological principle** which would have **realistically** impelled one having ordinary skill in the art to modify an applied reference to arrive at the claimed invention

based upon facts, -- not generalizations. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab, supra*; *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). That burden has not been discharged, as the Examiner has not provided the requisite factual basis that would have realistically impelled one having ordinary skill in this art to modify the Sangyo compression spring device to provide the strut positioning system comprising the rack plate and pinion gear, as required by claim 8.

The only teaching of the strut positioning system comprising the rack plate and pinion gear, as required by claim 8, is found in Applicants' disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Dependent claims 9-11 and 14 are allowable for at least the same reasons as claim 8 and further distinguish the claimed strut positioning system. For example, claim 9 further requires that the track comprises at least one landing positioned between the first position and the second position, the landing configured to prevent reverse translation of the rack plate in a direction toward the first position past the landing under a bias of the strut, and wherein the strut comprises at least one of a gas strut, a hydraulic strut, and a spring strut. Claim 10 further requires that the landing comprises a tab and wherein the rack plate comprises a stop member adapted to permit, in combination with the tab, movement of the rack plate over the tab only in a direction from the first position toward the second position. Claim 11 further requires that the stop member comprises a ratchet resiliently mounted on the rack plate. Sangyo and Talukdar et al. do not suggest the landings required by claims 9 and 10 and the ratchet required by claim 11.

**Application No.: 10/635,900**

In view of the above remarks, Applicants submit that this case should be allowed and passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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